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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/752,330

Filing Date: December 29, 2000

Appellant(s): MANTENA ET AL.

Wayne F. Reinke
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 19, 2006 appealing from the Office action mailed January 17, 2006.

(1) Real Party of Interest

A statement identifying the real party of interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

U.S. Patent Application Serial No. 09/751,069

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct. Regarding claim 13, the examiner notes that the appellant's summary includes a discussion of transmission queue (226), holding queue (232), and reply queue (234) on pages 6 and 7 of the Brief. This discussion merely serves to provide the Board with a better understanding of how the claimed invention works. It is not intended to identify the

structure corresponding to the means plus function language recited in the claim. The transmission queue, holding queue, and reply queue (as discussed on pages 6 and 7 of Brief) are not positively recited in the claims. Furthermore, the appellant did not argue in the Brief or prior prosecution history that they are the structure corresponding to the means plus function language recited in the claim. For this reason, the discussion of the transmission queue, holding queue, and reply queue is intended to provide the Board with a better understanding of how the claimed invention works, and it is not intended to identify the particular structure corresponding to the means plus function language recited in the claim.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

- A) US 2002/0087477 A1 now US Patent 6,999,949 Mantena et al. 02-2006
- B) US 6,889,197 B2 Lidow 05-2005
- C) Roberto Michel, "Multiplatform pursuits", Manufacturing Systems, Nov. 1998
(hereafter referred to as "Multiplatforms")

D) Official Notice

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-48 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-45 of copending Application No. 09/751,078 (US 2002/0087477 A1).

This is a provisional obviousness-type double patenting rejection. Application 09/751,078 substantially claims the same invention. The difference between these two applications is found to be non-functional descriptive material. Such differences are merely subjective and will not distinguish the claimed invention in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re*

Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to request any information because such information does not functionally relate to the steps of the claimed method and because the subjective interpretation of information does not patentably distinguish the claimed invention.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-3, 9-11, 13-15, 21-23, 25-27, 33-35, 37-39, and 45-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lidow (US 6,889,197 B2).

Referring to claims 1-3, 13-15, 25-27, and 37-39, Lidow teaches a method of providing an entitled price in an electronic transaction comprising: electronically sending by a requestor a request for information based on a preexisting entitlement (i.e. contract) from a public electronic environment (col. 7, lines 34-53; col. 23, line 64 – col. 24, line 7; col. 26, lines 62-67; Fig. 22); automatically routing the request to a private electronic environment (col. 9, lines 25-35; col. 25, lines 22-26; Figure 24, item “74”; col. 27, lines 20-42); obtaining an entitled price within the private electronic environment in real time while the requestor waits (col. 23, line 64 – col. 24, line 7; Figure 17, items “74” and “266”; Figure 24, item “74”; col. 27, lines 43-55); automatically returning the entitled price from the private electronic environment to the public electronic environment for providing to the requestor (col. 24, lines 19-39), wherein the public electronic

environment comprises a front end application, private electronic environment comprises a back end Enterprise Resource Planning application, electronically sending comprises electronically sending by the requestor the request via the front end application, automatically routing the request to the ERP application, obtaining the entitled price from the ERP application while the requestor waits, returning the entitled price from the ERP application to the front end application for providing to the requestor (col. 27, lines 20-67), wherein returning is accomplished at least in part by messaging middleware (col. 27, lines 56-67). Lidow does not teach that the information requested is an entitled price. However, the Examiner notes that this limitation is not functionally involved in the elements of the recited method. Therefore this limitation is deemed to be nonfunctional descriptive material. The steps of sending, routing, obtaining and returning would be performed the same regardless of what information the request contained. The difference between the content of the Applicant's information request and the prior art's demand is merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to request any information in the invention of Lidow because such information does not functionally relate to the steps of the claimed method and because the subjective interpretation of information does not patentably distinguish the claimed invention.

Referring to claims 9-11, 21-23, 33-35, 45-47, Lidow teaches that the public electronic environment comprises a global computer network (col. 26, lines 62-67). Lidow does not expressly teach that the front end application comprises a browser. However, Lidow teaches that the supply chain server 74 provides a web page with HMTL or Java data (col. 27, lines 8-13). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have the customer use a browser in the invention of Lidow. One of ordinary skill in the art would have been motivated to do so in order to view the HTML and Java data in a graphically enhanced user interface.

Claims 4-8, 16-20, 28-32, and 40-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lidow (US 6,889,197 B2) in view of Multiplatforms.

Referring to claim 4-8, 16-20, 28-32, and 40-44. Lidow discloses an invention according to claims 3, 15, 27, and 39 as indicated supra. Lidow does not expressly disclose a method wherein the messaging middleware comprises MQSERIES, MSMQ and the ESP application comprises BMN. However, Multiplatforms teach that enterprise software vendors have come to support multiple platforms (Multiplatforms: page 2). The examiner notes, the specific type of middleware being utilized by the instant invention does not act to distinguish the instant invention in terms of patentability. Numerous middleware applications and ESP configurations could have been implemented and successfully utilized. Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the invention of Lidow to have included various middleware applications and ESP configurations as discussed

above because multiple platform support from ERP vendors and greater platform interoperability means that manufacturing managers can consider a wider range of applications (Multiplatforms: page 3).

Claims 12, 24, 36, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lidow (US 6,889,197 B2) in view of Official Notice.

Lidow teaches or suggests all the limitations of claims 11, 23, 35, and 47 as noted above. Lidow does not teach encrypting and decrypting the communication between the various parties and systems. However, Official Notice is taken that it is old and well known in the art to encrypt and decrypt electronic messages. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate encryption and decryption into the invention of Lidow. One of ordinary skill in the art would have been motivated to do so in order to secure the communication between the various parties and systems.

(10) Response to Argument

Appellant's arguments (see pages 12 and 13 of Brief), with respect to the rejection of claims 1-48 under 35 U.S.C. 112, second paragraph have been fully considered and are persuasive. This rejection is withdrawn. The appellant agrees with the examiner's interpretation of the term "preexisting entitlement" as set forth by the examiner in the final Office Action (see page 3 of final Office Action).

Referring to the Double Patenting rejection of claims 1-48, the appellant argues that *In re Gulack* is a printed matter case and inapplicable to computer-based inventions

while *In re Lowry* concerns a data structure, which is not present in this case (see Brief pages 11 and 12). The appellant has also argued that the present claims recite an "entitled price" whereas US Patent 6,999,949 ('949) recites a "sales order". One is an inquiry while the other is an order (see Brief page 12). The examiner respectfully disagrees and directs the Board's attention to claim 1 of the '949 patent. That claim essentially covers the invention presented in claim 1 of the instant application. As noted by the appellant, claim 1 of the '949 patent recites a "sales order" while the current application recites an "entitled price". The examiner treated this difference as nonfunctional descriptive material because the steps of the method and the structure of the system of the present application are not responsive to or dependent on the content of the information being sent or received. The appellant has alleged that the examiner is improperly ignoring claim limitations. The examiner disagrees. No limitations were ignored in making the Double Patenting rejection. The examiner considered the claims as a whole and concluded that claim 1 of the current application includes nonfunctional descriptive material. MPEP 2106(IV)(B)(1)(b) clearly sets forth the guidelines for determining whether or not nonfunctional descriptive material is present in claim language by stating the following:

"Where certain types of descriptive material, such as music, literature, art, photographs and mere arrangements or compilations of facts or data, are merely stored so as to be read or outputted by a computer without creating any functional interrelationship, either as part of the stored data or as part of the computing processes performed by the computer, then such descriptive material alone does not impart functionality either to the data as so structured, or to the computer."

Thus the analysis requires the examiner to determine whether or not the particular piece of data creates any functional interrelationship, either as part of the stored data or as

part of the computing processes performed by the computer. In the present, the examiner cannot find any such functional interrelationship nor has the appellant argued that such a functional interrelationship exists in claim 1 of the present application. The appellant's main argument is that the case law cited by the examiner is improper because *In re Lowry* stands for the proposition that printed matter case is in applicable to computer-based inventions (see Brief page 12 and Arguments filed October 27, 2005, pages 12 and 13). The examiner respectfully disagrees. The *In re Lowry* decision by the U.S. Court of Appeals Federal Circuit found that the data in question created a functional interrelationship and therefore reversed the Board's decision. The Federal Circuit stated the following:

"Lowry's ADOs [attribute data objects] do not represent merely underlying data in a database. ADOs contain both information used by application programs and information regarding their physical interrelationships within a memory. Lowry's claims dictate how application programs manage information. Thus, Lowry's claims define functional characteristics of the memory...As Lowry notes, the data structures provide increased computing efficiency."

The examiner maintains that no such functional interrelationship is created by the term "entitled price" in claim 1 of the present application.

The appellant has also argued that claim 1 of the instant application recites obtaining the entitled price in "real time" whereas the claim of the '949 patent does not (see Brief page 12). The examiner notes that the term "real time" is a relative term that cannot be quantified. To support this point, the examiner cites the reference Kurose et al. "Computer Networking" ("Kurose"). Kurose teaches that in an electronic network such as the Internet, data packets suffer from a variety of delays (pages 41-43). These delays include processing delay (i.e. the time required to examine a packets header),

queuing delay (i.e. the time a packet waits to be transmitted onto a link), transmission delay (i.e. the time required to push a packet's bits into the link), and propagation delay (i.e. the required to travel the distance of the link). In addition, Kurose teaches that packet loss is very realistic in an electronic network and only adds to the delay because lost packets must be retransmitted (page 47). Thus even a "real time" electronic network will experience some sort of delay. The appellant's specification provides no guidance to one of ordinary skill in the art to determine the degree of delay a network should have in order to be considered "real time". The '949 patent uses an electronic network to transmit and receive data (col. 3, lines 11-33). Thus any delay in '949 patent can be considered "real time" because appellant's specification provides no guidance to determine the degree of delay a network should have in order to be considered "real time". For these reasons, the examiner respectfully requests the Board to affirm the examiner's double patenting rejection.

Referring to the rejection of claim 1 under 35 U.S.C. 103, the appellant argues the prior art does not teach that the price is obtained in "real time while the customer waits" (see Brief page 14). The examiner notes that the term "real time" is a relative term that cannot be quantified. To support this point, the examiner cites the reference Kurose et al. "Computer Networking" ("Kurose"). Kurose teaches that in an electronic network such as the Internet, data packets suffer from a variety of delays (pages 41-43). These delays include processing delay (i.e. the time required to examine a packets header), queuing delay (i.e. the time a packet waits to be transmitted onto a link), transmission delay (i.e. the time required to push a packet's bits into the link), and

propagation delay (i.e. the required to travel the distance of the link). In addition, Kurose teaches that packet loss is very realistic in an electronic network and only adds to the delay because lost packets must be retransmitted (page 47). Thus even a "real time" electronic network will experience some sort of delay. The appellant's specification provides no guidance to one of ordinary skill in the art to determine the degree of delay a network should have in order to be considered "real time". Lidow, the prior art cited by the examiner, uses an electronic network to transmit and receive data (col. 27, lines 32-67). Thus any delay in Lidow can be considered "real time" because appellant's specification provides no guidance to determine the degree of delay a network should have in order to be considered "real time".

The appellant has also argued that *In re Gulack* is a printed matter case and inapplicable to computer-based inventions while *In re Lowry* concerns a data structure, which is not present in this case (see Brief page 15). Thus, the appellant believes the term "entitled price" in claim 1 patentably distinguishes the claimed invention from the prior art. The examiner respectfully disagrees. The examiner considered claim 1 as a whole and concluded that the claim includes nonfunctional descriptive material. MPEP 2106(IV)(B)(1)(b) clearly sets forth the guidelines for determining whether or not nonfunctional descriptive material is present in claim language by stating the following:

"Where certain types of descriptive material, such as music, literature, art, photographs and mere arrangements or compilations of facts or data, are merely stored so as to be read or outputted by a computer without creating any functional interrelationship, either as part of the stored data or as part of the computing processes performed by the computer, then such descriptive material alone does not impart functionality either to the data as so structured, or to the computer."

Thus the analysis requires the examiner to determine whether or not the particular piece of data creates any functional interrelationship, either as part of the stored data or as part of the computing processes performed by the computer. In the present, the examiner cannot find any such functional interrelationship nor has the appellant argued that such a functional interrelationship exists in claim 1 of the present application. The appellant's main argument is that the case law cited by the examiner is improper because *In re Lowry* stands for the proposition that printed matter case is in applicable to computer-based inventions (see Brief page 12 and Arguments filed October 27, 2005, pages 12 and 13). The examiner respectfully disagrees. The *In re Lowry* decision by the U.S. Court of Appeals Federal Circuit found that the data in question created a functional interrelationship and therefore reversed the Board's decision. The Federal Circuit stated the following:

"Lowry's ADOs [attribute data objects] do not represent merely underlying data in a database. ADOs contain both information used by application programs and information regarding their physical interrelationships within a memory. Lowry's claims dictate how application programs manage information. Thus, Lowry's claims define functional characteristics of the memory...As Lowry notes, the data structures provide increased computing efficiency."

The examiner maintains that no such functional interrelationship is created by the term "entitled price" in claim 1 of the present application. For these reasons, the examiner respectfully requests the Board to affirm the examiner's rejection of claim 1 under 35 U.S.C. 103.

Referring to the rejection of claim 10 under 35 U.S.C. 103, the appellant argues that the examiner did not directly address this claim (see Brief page 16). The limitations of claim 10 are either explicitly taught or inherent in the disclosure of Lidow. Against

these limitations, the examiner directs the Board's attention to sections of the Lidow reference as follows:

forwarding the request from the global computer network site server to messaging middleware (col. 27, lines 29-31; Figure 24, item "588");
sending the request from the messaging middleware to the ERP application (col. 27, lines 58-60).

Regarding the limitation "causing by the messaging middleware a command to be issued to the ERP application", the examiner notes that this limitation is inherent in the disclosure of Lidow. Lidow discloses that the "Extranet Manager" (Figure 24, item "580") and the "Messaging Services" (Figure 24, item "588") sit between the ERP application and the external parties (e.g. customer, suppliers, and banks). Therefore all communication (e.g. a command) between the external parties and the ERP system must go through one of the middleware software. Microsoft Press Computer Dictionary, third edition, defines the term "middleware" as software that sits between two or more types of software and translates information between them. The examiner treated the "Extranet Manager" and "Messaging Services" of Lidow as middleware. For these reasons, the examiner respectfully requests the Board to affirm the examiner's rejection of claim 10.

Finally, the appellant has argued to maintain the right to subsequently challenge the Lidow reference because, as alleged by appellant, it is unclear whether Lidow's priority to US Provisional Application 60/175,868 is even proper (see Brief page 16). The examiner has reviewed the provisional application and notes that the provisional

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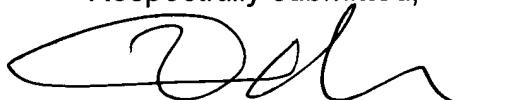
application provides adequate support for the Lidow Patent. The examiner also notes that appellant has not specifically pointed out a particular feature of the Lidow Patent which the appellant believes lacks proper support in the provisional application.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Naeem Haq, Primary Examiner (AU 3625)

September 5, 2006

Conferees:



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